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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,210	12/02/2003	Gary Shipton	PEA10US	4608
24011	7590	02/15/2005	EXAMINER	
SILVERBROOK RESEARCH PTY LTD 393 DARLING STREET BALMAIN, 2041 AUSTRALIA			ASSOUAD, PATRICK J	
			ART UNIT	PAPER NUMBER
			2857	

DATE MAILED: 02/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

CT

Office Action Summary	Application No. 10/727,210	Applicant(s) SHIPTON ET AL.	
	Examiner Patrick J. Assouad	Art Unit 2857	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, 5-8, 10 and 13 is/are rejected.
- 7) ☒ Claim(s) 2, 4, 9, 11, 12 and 14-17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☒ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/2/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Australia on 12/2/02. It is noted, however, that applicant has not filed a certified copy of the Australian application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

2. The information disclosure statement (IDS) filed 12/2/04 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because the documents cited therein do not appear to be relevant to patentability of the instant claimed invention. The references appear to be related to identifying malfunctioning print heads. The IDS has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609 ¶ C(1).

3. The listing of references in the specification (see pgs. 1063-1067) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP

§ 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

4. The lengthy specification (1000+ pages) has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification. For example, on pg. 548, we see: "Please note that pages 549-554 are intentionally missing." This will probably generate a printer's "rush" if the application is allowed.

5. The incorporation of essential material in the specification by reference (Applicant uses the term "cross-reference") to a foreign application or patent, or to a publication is improper. See pages 1063-1067 of the instant Specification. Applicant is required to amend the disclosure to include the material incorporated by reference if Applicant considers the material essential. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. The instant Specification is over 1000 pages long. Applicant is required to show the antecedent basis in the Specification for all claimed elements (i.e. the precise location of all claimed elements or steps).

Drawings

9. There are 331 sheets of Drawings and at least 413 Figures. The drawings must show every feature of the invention specified in the claims. See 37 CFR 1.83(a). Applicant is required to show where each and every claimed element or step is shown in the Drawings.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

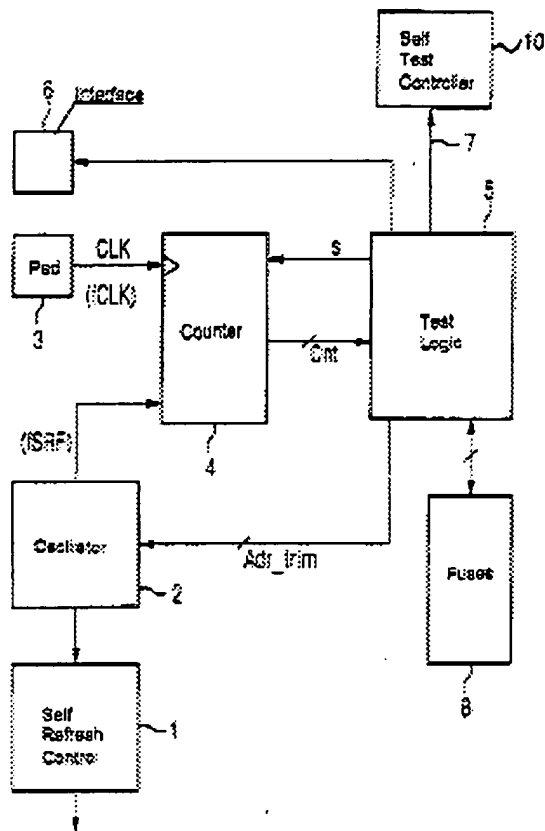
Art Unit: 2857

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1, 3, 5-8, 10 and 13 are rejected under 35 U.S.C. 102(e) as being anticipated by Beer et al. (US 6,671,221 B2) filed 5/23/02 and patented 12/30/03.

12. The lone Figure of Beer et al. is reproduced below. From their Abstract, we see disclosed:

A semiconductor chip, particularly a semiconductor memory, has a trimmable oscillator for controlling internal functions. A circuit is provided for trimming the frequency of the oscillator and is implemented on the semiconductor chip. This guarantees a parallel setting of the oscillator frequency for a plurality of semiconductor chips without losses in yield or quality.



13. The one-to-one correspondence between the instant claimed invention (independent claim 1) and that of Beers et al. is as follows: the processor is controller (10); the onboard system clock is fSRF produced by oscillator (2); the clock trim circuitry is a test logic (5) and fuses (8); receiving an external signal is the external clock signal CLK or fCLK; determining either the number of cycles of the clock signal... is the number of cycles of the clock signal CLK being detected by the counter (4) for n periods, n being a whole positive number; determining a trim value and storing the trim value for controlling the internal clock frequency is performed by the test logic (5) which generates the command ADR_trim at a corresponding correction address to modify or

set or trim the frequency fSRF of the oscillator (2) and note that the correction value may be deposited into the bank of fuses (8).

14. As per dependent claims 3 and 6-7, see at least col. 3, lines 34-38, of Beers et al.:

On-chip fuses are also advantageously provided for storing corresponding correction information for the on-chip oscillator. Preferably, electrical fuses are utilized for the on-chip fuses.

15. As per dependent claim 5, see at least col. 4, lines 43-47, of Beers et al.

16. As per dependent claim 8, the Examiner associated Oscillator 2 with the claimed VCO. This is a well-known oscillator frequently utilized on semiconductor chips.

17. As per dependent claim 10, see at least lines 27-36 of Beers et al.

18. As per dependent claim 13, see at least the external clock signal CLK pad(3) and the (external) Interface 6 of Beers et al.

Allowable Subject Matter

19. Claims 2, 4, 9, 11-12, and 14-17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

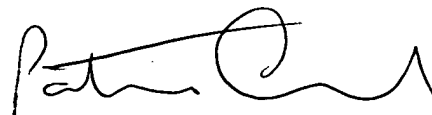
Conclusion

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See the attached PTO-892. Most notable is Hull et al. (US 5,796,312).

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick J. Assouad whose telephone number is 571-272-2210. The examiner can normally be reached on Tuesday-Friday, 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marc Hoff can be reached on 571-272-2216. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick J Assouad
Primary Examiner
Art Unit 2857